



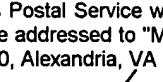
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) LVIP:108US	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>January 20, 2006</u></p> <p>Signature </p> <p>Typed or printed name <u>C. Paul Maliszewski</u></p>		Application Number 10/734,566	Filed 12/12/2003
<p>First Named Inventor Reinhard Lihl</p> <p>Art Unit 3724</p> <p>Examiner Kenneth E. Peterson</p>			

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 51,990

Signature

C. Paul Maliszewski

Typed or printed name

716-626-1564

Telephone number

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

January 20, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. LVIP:108US
U.S. Patent Application No. 10/734,566
Reply to Office Action of October 17, 2005
Date: January 20, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 10/734,566

Confirmation No.: 1877

Applicant(s): LIHL, Reinhard et al.

For: APPARATUS FOR CUTTING SPECIMENS HAVING AN AUTOMATIC PRESETTING APPARATUS

Filed: December 12, 2003

TC/Art Unit: 3724

Examiner: PETERSON, Kenneth E.

Docket No.: LVIP:108US

Customer No.: 24041

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C. Paul Maliszewski
Regis. No. 51,990

PRE-APPEAL BRIEF REQUEST FOR REVIEW WITH ARGUMENTS

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

This Pre-Appeal Brief Request for Review is in response to the Final Office Action dated October 17, 2005 and the Advisory Action dated December 19, 2005 regarding the above-identified patent application.

A Notice of Appeal also has been filed this day for the above case.

Arguments begin on page 2 of this paper.

A check in the amount of \$620.00 is enclosed for a Notice of Appeal fee and a Petition and fee for a one month extension of time.

Remarks/Arguments

For the sake of brevity, only independent claims are addressed in this reply. It is understood that arguments regarding the independent claims apply to respective claims dependent from the independent claims.

Arguments below are taken from the respective Requests for Reconsideration filed on August 26, 2005 and November 16, 2005 regarding the above-identified patent application.

Rejection of Claims 2-7 and 9 under 35 U.S.C. §103(a)

The Examiner rejected Claims 2-7 and 9 under 35 U.S.C. §103(a) as being unpatentable over European Patent No. 0544181 (Niesporek) in view of the Examiner's Official Notice of knowledge well known in the art and U.S. Patent No. 5,488,886 (Mohr). Applicants respectfully traverse the rejections.

I. Provided No Motivation or Suggestion to Combine References

In the Examiner's final rejection of Claims 2-7 and 9 the Examiner determined that the claims were unpatentable due to obviousness over the primary reference (European Patent No. 0544181 (Niesporek), which describes a cutting apparatus that uses a contact sensor, and U.S. Patent No. 5,488,886 (Mohr), which describes a guillotine style bulk paper cutter. The Examiner reasoned that contact sensors as used Niesporek could be replaced by the light barrier used in Mohr offered no motivation to combine these elements from references in disparate fields.

Elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 U.S.P.Q.2d 1430. The Examiner has provided no motivation outside perfunctory statements that the two references should be combined.

II. Applied Impermissible Hindsight

To bolster his position the Examiner stated that it was common knowledge that light barriers are equivalents of contact sensor, but offers no proof other than his statement that it is well known. Deficiencies of the cited references cannot be remedied by general conclusions

about what is “basic knowledge,” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings. See *In re Zurko* 258 F. 3d at 1386, 59 USPQ2d at 1697 (Fed. Cir. 2001). Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention … when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). The Examiner has applied impermissible hindsight to provide the motivation to modify Niesporek.

III. Examiner Failed to Show Equivalency

The Examiner also asserted that one of ordinary skill in the art would consider using a light barrier over a contact sensor because the two sensors are art-recognized equivalents. Relying on equivalence as a rationale to support an obviousness rejection requires that the equivalency be art recognized. MPEP §2144.06. Stating that two components are art-recognized equivalents sets the stage for offering evidence of equivalency, but more is needed than a mere assertion. The Examiner has failed to substantiate the claim that contact sensors and light barriers are art-recognized equivalents. Other than the statement that light barriers and contact sensors are art recognized equivalents the Examiner has not offered any other support that they are indeed equivalents. Applicant contested this statement (on pg 6 and 7 of November 29, 2005 response) as being insufficient support for the Examiner’s position and argues that the Examiner has not properly supported his position that the light barriers and art recognized equivalents of contact sensors. Equivalency cannot be “based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” MPEP §2144.06, *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

IV. Examiner has relied on references that are non-analogous to the instant invention

Before an Examiner can rely on a reference as a basis for an obviousness rejection “the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” *In re Oetiker*. 977 F.2d 1443 (Fed. Cir. 1986). The Examiner cited Mohr to provide motivation to replace a contact

sensor with a light barrier in a microtome. Mohr is not analogous to the present invention. Mohr teaches a hydraulic, guillotine, bench cutting machine for cutting sheets of material stacked on a bench (Abstract and Figure 1). That is, Mohr is cutting a plurality of longitudinal sheets orthogonal to the face/surface of the sheets. Specifically Mohr teaches moving a guillotine blade to cut fixed, stacked sheets of paper, cardboard, or similar material (col. 5, lines 39-41). The present invention moves a very small specimen with respect to a fixed knife to slice off sections of the specimen.

Further, the present invention is using a light barrier to prevent damage to a microtome knife or to a specimen being cut, as well as increasing the precision of the cutting action of the microtome. In contrast, Mohr does not teach, suggest, or motivate using a light barrier to prevent damage to the cutting mechanism or the sample being cut. Neither does Mohr suggest or motivate using a light barrier to increase the precision of the cutting action in a microtome.

For all the reasons presented above, Niesporek fails to form a *prima facie* case of obviousness with respect to Claim 9. Therefore, Claim 9 is patentable over Niesporek. Claims 2-7, dependent from Claim 9, enjoy the same distinction from the cited prior art. Applicants courteously request that the rejection be removed.

Rejection of Claims 2-7 and 9 under 35 U.S.C. §103(a)

In the Final Office Action, the Examiner rejected Claims 2-7 and 9 under 35 U.S.C. §103(a) as being obvious over European Patent No. 0544181 (Niesporek) in view of the Examiner's Official Notice of knowledge well known in the art and U.S. Patent No. 5,488,886 (Mohr).

On page 5 and 6 of the Amendment and Request for Reconsideration filed on August 26, 2006, Applicants show that Niesporek does not teach measuring a distance between a specimen and a knife. However, Niesporek teaches a different type of mechanism (a limiter) that performs a different function than that which is recited in Claim 9.

The Examiner argued in the Final Office Action of October 17, 2005 that the combination of Mohr and Niesporek renders the invention recited in Claim 2-7 and 9 obvious. In the response filed on August 26, 2005 Applicant showed on page 6 that the combination is

improper since the Mohr and Niesporek are from non-analogous arts. On page 7 of that same response Applicant's showed that there is no suggestion or motivation to modify Niesporek or combine Niesporek and Mohr since Mohr solves a different problem than that solved by the present invention.

In a Request for Reconsideration filed November 29, 2005 after the Final Office Action, Applicants show again that the combination of Niesporek and Mohr is improper because the Examiner provided no motivation or suggestion to combine and that the Examiner applied impermissible hindsight in combining Niesporek and Mohr in the obviousness rejection (see page 6).

In the Final Office Action, the Examiner argued that contact sensors and light barriers are art recognized equivalents and hence the substitution of the contact sensor in Niesporek for the light barrier in Mohr was motivated by this equivalence. Applicant's have shown that the Examiner was incorrect in combining these references since more is needed to show equivalency than an unsubstantiated claim by an Examiner (see bottom of page 6 and top of page 7 of November 29, 2005 response).

Conclusion

Applicant respectfully submits that all pending claims are in condition for allowance, which action is courteously requested.

Respectfully submitted,



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